

REMARKS

Applicants thank the Examiner for allowing claims 1-2, 4-7, 9-13, 17-21 and 27-30, and for the indication of allowable subject matter with respect to claim 24. As a result, claims 23, 24 and 26 remain pending, and are subject to either a rejection or an objection.

The application has been amended. In particular, independent claim 23 has been amended to clarify that the bending or flexing of the actuator causes the relative axial displacement. Also, claim 24 has been amended to independent form. No new matter was added by these amendments. In view of the foregoing amendment and following remarks, Applicants respectfully request reconsideration of the application.

Initially, Applicants note that original claims 1-33 were previously subject to a restriction requirement. In response, the Applicants had traversed the restriction requirement, and provisionally elected species D. However, the Examiner has maintained the restriction requirement, and has withdrawn claims 3, 8, 14-16, 22, 25 and 31-33, as directed to the non-elected species. Applicants submit that the withdrawal of these non-elected species claims after allowance of generic claims is improper. In particular, the claims were restricted by the Examiner as being directed to a number of patentably distinct species. In the Restriction Requirement dated September 7, 2006, the Examiner recognized that "Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141." Moreover, MPEP §821.04(a) specifically recites as follows:

Where restriction was required between independent or distinct products, or between independent or distinct processes, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn. For example, a requirement for restriction should be withdrawn when a generic claim, linking claim, or subcombination claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof. Claims that require

all the limitations of an allowable claim will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104.

The November 16, 2006 Office Action specifically states that “the Examiner agrees that claims 1, 23 and 27 are generic”, and has indicated that all of these generic claims are allowable. Accordingly, Applicants submit that withdrawal of the non-elected claims, after the indication of allowable generic claims is improper. Applicants therefore respectfully request rejoiner of all of the withdrawn claims. Moreover, since the withdrawn claims are dependent claims depending either directly or indirectly from allowable independent claims and therefore include all of the limitations thereof, Applicants submit that allowance of all of these withdrawn claims is appropriate, and is respectfully requested.

Although the Office Action identifies claims 1-2 and 27-29 as being allowed, these claims nevertheless are noted as rejected based on a nonstatutory obviousness-type double patenting rejection, as being unpatentable over claims 1-3 and 25 in U.S. Patent No. 6,855,128. Enclosed with the present Amendment is a Terminal Disclaimer, disclaiming the term of any patent to issue from the present application that would extend beyond the term of U.S. Patent No. 6,855,128. In view of this Terminal Disclaimer, this rejection is obviated. Withdrawal of this rejection is therefore respectfully requested.

Also, claim 24 is objected to as being dependent upon rejected claim 23, but is identified as allowable if rewritten in independent form. The above amendments to the claims rewrites claim 24 into independent form. As such, Applicants respectfully submit that claim 24 is in allowable form. Withdrawal of this objection is therefore respectfully requested.

Claims 23 and 26 stand rejected under 35 U.S.C. §102(a) or (e) as allegedly anticipated by Thorne (U.S. Pat. No. 6,224,576). In view of the remarks herein, this rejection is respectfully traversed.

The presently claimed invention involves a needle assembly that is adapted for blunting both an intravenous puncture tip and a non-patient puncture tip. In pertinent part, claim 23 recites a method for blunting a needle assemble comprising the step of bending or flexing an actuator within an opening extending through a hub. The bending or flexing of the actuator causes axial

displacement between an intravenous puncture tip and a first blunting tip, and also causes axial displacement between a non-patient puncture tip and a second blunting tip.

In contrast, Thorne discloses shielding only of an intravenous puncture tip through an actuator. For example, in Thorne, activation of an actuator button (190) causes movement of the distal shield segment (188) of the needle shield (162) with respect to the proximal shield segment (186) and the needle hub (164). (See Thorne FIGS. 2-6). The actuator button does not in any way cause axial displacement of any blunting member with respect to the non-patient needle end. While Thorne discloses a shield (158) for the non-patient needle tip (100'), such a shield (158) is not caused to blunt the non-patient needle tip based on the actuator. Instead, the non-patient needle tip (100') is shielded when the needle assembly is not attached to the phlebotomy barrel (168), and is exposed only after a threaded section (166) is threadably joined to the phlebotomy barrel (168). When the threaded section (166) is threadably removed from the phlebotomy barrel (168), the shielding device is lengthened, thereby extending the rear needle shield (158) over the rear needle tip (100'). (See Thorne at column 6, lines 11-14; column 7, lines 3-24; and FIGS 2, 3 and 8). Such movement and shielding of the non-patient needle tip is caused independently of the shielding of the intravenous puncture tip, and through a different mechanism.

Thorne does not disclose, teach or suggest blunting both an intravenous puncture tip and a non-patient puncture tip by bending or flexing an actuator, as is claimed in the present application. Particularly, Thorne only discloses shielding one end of the needle (100) upon activating the actuator button (190). The mechanism for shielding the non-patient needle end (100') disclosed in Thorne is not controlled by the actuator button (190). Instead, it is controlled by threadably joining the threaded section (166) to a phlebotomy barrel (168). Thus, pushing the actuator button (190) on the device disclosed in Thorne only blunts one needle end (100), not both needle ends (100, 100').

Additionally, the mechanism for shielding the front needle (100) disclosed in Thorne does not involve flexing or bending an actuator through an opening in the hub. Instead, it involves movement of a mechanism outside of the hub (164). Therefore, Thorne does not disclose, teach or suggest bending or flexing an actuator through an opening in the hub, as is recited in claims 23 and

Application No. 10/617,340
Paper Dated: March 14, 2007
Attorney Docket No. 3896-030281 (P-5344P1)

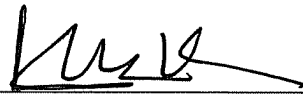
26 of the present application. As such, Thorne fails to disclose, teach or suggest all of the claimed features of the present invention. Applicants therefore submit that the rejections based on Thorne are improper, and respectfully requests withdrawal thereof.

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims in the instant application are novel over the prior art and are in condition for allowance. Accordingly, rejoinder of the withdrawn claims, reconsideration and withdrawal of the rejections and objections, and a notice of allowance are respectfully requested.

Should the Examiner have any questions or concerns, the Examiner is invited to contact Applicants undersigned attorney by telephone at 412-471-8815.

Respectfully submitted,

THE WEBB LAW FIRM

By 

Kirk M. Miles
Registration No. 37,891
Attorney for Applicants
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com